

### **REMARKS/ARGUMENTS**

Reconsideration of this application is requested. Claims 1-9 continue to be active in this application.

As a preliminary matter, attention is again directed to the filing of a certified copy of the priority document which was submitted with the original application papers on March 21, 2002. To date, applicants have not received an acknowledgement of this document – the printed form on page 1 of the Official Action of March 28, 2005 contains no acknowledgement nor do the printed forms included with the Official Actions of Paper No. 8 as well as Paper No. 4. The examiner is requested to acknowledge receipt of the filing of this certified copy. This is the third time the undersigned has made a request to have receipt of this certified copy acknowledged; *see* the response of August 17, 2001, page 1, first paragraph, and the Amendment of February 7, 2002, page 3, second paragraph. If the examiner requires further information or documentation with respect to applicants' claim for benefit of priority, please contact the undersigned for further documentation or information.

A second preliminary matter relates to two Information Disclosure Statements that were submitted but have not, as of yet, been acknowledged, dated, initialed, etc., as was requested at the time these two documents were filed. By this I am referring to the Letter submitted February 11, 2002 and the PTO-1449 form attached to it (an earlier version of the same form was submitted with the response of August 17, 2001). I also refer to the Information Disclosure Statement filed August 11, 2004. If for any reason the relevant information or documentation is not present in the examiner's file, please contact the undersigned and such documentation will be supplied. In any event acknowledgement and an indication these IDSs were considered is awaited.

Claim 1 is amended to specify an amount of the polyglycerol fatty acid ester - a relatively small amount - included in the milk beverage composition being claimed. Basis for this amount may be found in the specification at page 10, lines 10 and 11. The examiner will also note the amount of emulsifier used in Example 4 is 0.05% and in Examples 5-8 is 0.1%. Note also the range of a specific emulsifier specified in claim 8.

An object of the present invention is to provide a milk beverage capable of **maintaining an emulsion stability for a long period of time even when being subjected to UHT sterilization.**

An aspect of the present invention is to provide a milk beverage comprising a **0.01 to 0.1% by weight of** polyglycerol fatty acid ester having a cloud point of not less than 90°C when measured at a concentration of 1% by weight in a 20% sodium chloride aqueous solution containing said ester.

Namely, by using a polyglycerol fatty acid ester having the specified cloud point in a small amount, emulsion stability of milk beverage can be maintained for a long period of time even when being subjected to UHT sterilization.

Claims 1-9 are rejected under 35 USC §103(a) as being "obvious" over a combination of Bernhardt (EP 0236288, Rule (US 4,419,378), Babayan (US 4,093,750), and Talkington (US 4,960,602)<sup>1</sup>.

Bernhardt describes a composition of matter (that eliminates laxative side effects) composed of an edible, wholly or partially nondigestible **low calorie fat material** used for reducing serum cholesterol, which contains polyglycerol fatty acid esters and sugar fatty acid polyesters.

Rule describes a milk-containing beverage containing polyglycerol esters of fatty acids.

Babayan relates to beverages containing a polyglycerol ester of a fatty acid.

Talkington features the use of sucrose fatty acid esters in foods and beverages.

The crux of the examiner's position appears to be that stated on page 3, second paragraph of the Official Action in which it is argued "the specific cloud point is no more than obvious to that of the prior art" coupled with the comment in the following paragraph "the use and manipulation of polyglycerol fatty acid esters in milk products is conventional in the art".

The issue conspicuously not addressed is exactly what is being manipulated. Polyglycerol fatty acid esters have many components, functionalities and capabilities, and while the examiner has chosen to focus on cloud point the cited references do not.

---

<sup>1</sup> It is noted that four references have been asserted as the basis of the Examiner's obviousness rejection (and on page 3 two additional citations, not applied, are noted "as of interest"). As the courts have stated, the fact that it is necessary to cite a large number of references is, in and of itself, indicative of non-obviousness.

In all of the applied references, there is no description nor suggestion of milk beverage capable of maintaining an emulsion stability for a long period of time even when being subjected to UHT sterilization, and that by using a polyglycerol fatty acid ester having a specific cloud point, the above object can be attained.

It is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead one of ordinary skill in the art to combine those references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617-18 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”)

Merely asserting that it would have been within the skill of the art to substitute one type of polyglycerol ester of a fatty acid for another in the polyglycerol fatty acid esters and sugar fatty acid polyesters of Bernhardt is not enough. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (Holding that there was no support for the Examiner’s mere assertion that it would have been obvious to substitute one type of detector for another in the system of the primary reference); *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992) (Holding that there was no suggestion to combine a primary herbicide reference with secondary references directed to shampoo additives or byproducts of morpholines to arrive at the claimed invention.); MPEP § 2143.01.

There is nothing in any of the cited references to suggest the desirability of the combination or modification in the manner indicated by the Examiner. Specifically, there is no motivation or suggestion to focus upon a specific cloud point.

Thus, the mere fact that references can be combined or modified (and Applicants believe they cannot be) does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); MPEP § 2143.01. Hence, the Examiner’s attempt to combine the cited references alone without any suggestion in the references themselves of the desirability of the modification is improper and should be withdrawn.

---

*Minneapolis-Honeywell Regulator Company v. Midwestern Instruments, Inc.*, 298 F.2d 36, 38, 131 U.S.P.Q. 402, 403 (7th Cir. 1961).

Considering in more detail the primary reference, in Bernhardt, on page 13, lines 4-10, there is a statement that "The low calorie fat materials of the present invention can be used as a partial or total replacement for normal triglyceride fat in any fat-containing food composition to provide low calorie benefits. In order to obtain a significant low calorie effect, it is necessary that at least about 10% of the fat in the food composition, or 33% of the calorie value of the food, comprises the low calorie fat materials." (emphasis added)

Clearly, in order to attain the objectives of Bernhardt, very large amount of normal fat **must be replaced by an equal amount of a low calorie fat material**, which comprises polyglycerol fatty acid esters and sugar fatty acid polyesters. Therefore, very large amounts of low calorie fat material must be added into foods. For his objective as a low calorie fat replacement Bernhardt requires a significant amount of low calorie replacement.

In distinct contrast, in the present invention, very small amounts (**0.01 to 0.1 %** by weight) is used in order to **maintain an emulsion stability for a long period of time even when being subjected to UHT sterilization.**

The examiner argues that "It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to manipulate polyglycerol fatty acid esters as taught by Rule, Babayan, and Talkington in the milk product of Bernhardt". Assuming *arguendo* this is done, following the requirements of Bernhardt, if the polyglycerol fatty acid esters as taught by Rule, Babayan, and Talkington are used in the dairy products of Bernhardt, a very large amount of normal fat **must be replaced by** polyglycerol fatty acid esters as taught by Rule, Babayan, and Talkington. Namely, even though very small amounts (**0.01 to 0.1 %** by weight) of polyglycerol fatty acid esters as taught by Rule, Babayan, and Talkington is added (**not for replacement**), there are no calorie reduction benefits and the objectives of Bernhardt cannot be attained.

Therefore, even if one combines Bernhardt with Rule, Babayan and Talkington, one of ordinary skill in the art cannot appreciate and arrive at applicants' milk beverage containing a small amount (**0.01 to 0.1 % by weight**) of polyglycerol fatty acid ester having a specific cloud point.

Accordingly, applicants' claims are not obvious from the combination of Bernhardt with Rule, Babayan and Talkington.

OGAWA et al.  
Appl. No. 09/532,024  
June 23, 2005

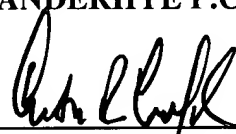
For the above reasons it is respectfully submitted that the combination of references is inappropriate and, further, that even if the references are combined, the overall teachings of the combined documents are not suggestive of the claims now under review.

Reconsideration and favorable action are solicited. Should the examiner require further information, please contact the undersigned.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_



Arthur R. Crawford  
Reg. No. 25,327

ARC:eaw  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100